UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/938,023 | 08/22/2001 | Marcellus Buchheit | B-72914 | 1135 |

7590 11/03/2004

Michael E. Martin
Gardere Wynne Sewell LLP
1601 Elm Street
Suite 3000
Dallas, TX 75201-4761

| EXAMINER | |
|---|---|
| ABRISHAMKAR, KAVEH | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2131 | 5 |

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/938,023 | BUCHHEIT ET AL. | |
| | Examiner | Art Unit | |
| | Kaveh Abrishamkar | 2131 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *13-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This action is in response to the communication filed on August 22, 2001. Claims 1 – 12 were originally received for consideration. But per the preliminary amendment received on August 22, 2001, claims 1 – 12 are cancelled, and new claims 13 – 34 are added. Claims 13 – 34 are currently being considered.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claim 14, the phrase "anyone else" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The phrase "anyone else" can pertain to any number of possible candidates and therefore is viewed as indefinite.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 13 – 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen (U.S. Patent 6,233,567).

Regarding claim 13, Cohen discloses:

A procedure for the protection of computer software and/or computer-readable data against unauthorized use, including the steps of:

encoding of software or data by a licenser dependent on license parameters containing a Firm Code (FC) assigned to said licenser and a User Code (UC) allocated by said licenser of the software or the data, which together initiate the encoding (column 3 lines 28 – 67, column 5 line 28 – column 6 line 19);

storing the encoded software or data on a data medium of a licensee (Figure 1 item 72, column 3 lines 65 – 67);

sending an encoded transmission of the license parameters from said licenser to said licensee (column 6 lines 1 – 37);

storing the license parameters in a nonvolatile memory of said licensee (Figure 4 item 120, column 6 lines 11 – 20);

automatically decoding the software or data by means of a decoder dependent on the storage license parameters during the use of the software or data by said licensee wherein:

encoding of software or data is initialized dependent on a secret Firm Key (FK) freely selected by said licenser (column 3 lines 28 – 67, column 5 line 28 – column 6 line 19);

the encoding of the transmission of the license parameters occurs dependent on a secret Private Serial Key (SK) (column 2 lines 35 – 49, column 6 lines 1 – 37); and

the decoding of the software or data is initialized dependent on the Firm Key (FK) selected by said licenser (column 5 line 28 – column 6 line 37).

Regarding claim 25, Cohen discloses:

A procedure for the protection of computer software and/or computer-readable data against unauthorized use, including the steps of:

encoding of software or data by a licenser dependent on a license parameters containing a Firm Code (FC) assigned to said licenser and a User Code (UC) allocated by said licenser of the software or the data, which together initiate the encoding (column 3 lines 28 – 67, column 5 line 28 – column 6 line 19);

storing the encoded software or data on a data medium of a licensee (Figure 1 item 72, column 3 lines 65 – 67);

sending an encoded transmission of the license parameters from said licenser to said licensee (column 6 lines 1 – 37);

automatically decoding the software or data by means of a decoder dependent on the license parameters during the use of the software or data by said licensee (column 5 line 28 – column 6 line 37);

initializing encoding of software or data dependent on the Firm Key (FK) selected by said licenser (column 3 lines 28 – 67, column 5 line 28 – column 6 line 19);

encoding of the transmission of the license parameters dependent on a secret Private Serial Key (SK) (column 2 lines 35 – 49, column 6 lines 1 – 37);

initializing decoding of the software or data dependent on the Firm Key (FK) selected by said licenser (column 5 line 28 – column 6 line 37);

producing the secret Private Serial Key (SK) randomly at said licensee (column 2 lines 35 – 49, column 6 lines 1 – 37); and

storing the license parameters within a memory of a protective device (Figure 4 item 120, column 6 lines 11 – 20).

Regarding claim 31, Cohen discloses:

A protective device for use in a procedure which includes:

encoding of software or data by a licenser dependent on license parameters containing a Firm Code (FC) assigned to said licenser and a User Code (UC) allocated by said licenser of the software or the data, which together initiate the encoding (column 3 lines 28 – 67, column 5 line 28 – column 6 line 19);

storing the encoded software or data on a data medium of a licensee (Figure 1 item 72, column 3 lines 65 – 67);

sending an encoded transmission of the license parameters from said licenser to said licensee (column 6 lines 1 – 37);

automatically decoding the software or data by means of a decoder dependent on the license parameters during the use of the software or data by said licensee (column 5 line 28 – column 6 line 37);

initializing encoding of software or data dependent on a secret Firm Key (FK) freely selected by said licenser (column 3 lines 28 – 67, column 5 line 28 – column 6 line 19);

encoding the transmission of the license parameters dependent on a secret Private Serial Key (SK) (column 2 lines 35 – 49, column 6 lines 1 – 37); and

initializing the decoding of the software or data dependent on the Firm Key (FK) selected by said licenser (column 5 line 28 – column 6 line 37), said protective device comprising:

an interface for connection with a computer of said licensee (Figure 1 items 82 and 54);

a microprocessor (Figure 1 item 84);

a nonvolatile memory in which the license parameters are stored (Figure 4 item 120, column 6 lines 11 – 20);

an encoder and decoder for the automatic decoding of the software or data dependent on the stored license parameters (column 5 line 28 – column 6 line 37); and

an installation for the production of a random secret Private Serial Key (SK) for the encoding of the transmission of the license parameters between said licenser and said licensee (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 14 is rejected as applied above in rejecting claim 13. Furthermore, Cohen discloses:

A procedure in accordance with claim 13, wherein:

the secret Private Serial Key (SK) is produced randomly, at said licensee without said licensee, said licenser, or anyone else being able to influence that (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 15 is rejected as applied above in rejecting claim 13. Furthermore, Cohen discloses:

A procedure in accordance with claim1 3, wherein:

the signature of the transmission of the license parameters from said licenser to said licensee occurs dependent on a unique Serial Number (SN) firmly assigned to said licensee (column 2 lines 50 – 55, column 4 lines 1 – 8).

Claim 16 is rejected as applied above in rejecting claim 13. Furthermore, Cohen discloses:

A procedure in accordance with claim 13 wherein:

said licenser is assigned a secret Firm Common Key (FCK), which is produced from a Common Key (CK) through encoding dependent on the Firm Code (FC) of said licenser (column 6 line 63 – column 7 line 8); and

the installation, changing, or deletion of the license parameters occurs dependent on the Firm Common Key (FCK) (column 6 line 63 – column 7 line 8).

Claim 17 is rejected as applied above in rejecting claim 13. Furthermore, Cohen discloses:

A procedure in accordance with claim 13 wherein:

the storage of the license parameters occurs within a protective device developed as a hardware supplement ((Figure 4 item 120, column 6 lines 11 – 20).

Claim 21 is rejected as applied above in rejecting claim 13. Furthermore, Cohen discloses:

A protective device for use in a procedure in accordance with claim 13, comprising:

an interface for connection with a computer of said licensee (Figure 1 items 82 and 54);

a microprocessor (Figure 1 item 84);

a nonvolatile memory in which the license parameters are stored (Figure 4 item 120, column 6 lines 11 – 20); and

an installation for the production of a random secret Private Serial Key (SK) for the encoding of the transmission of the license parameters between said licenser and said licensee (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 26 is rejected as applied above in rejecting claim 25. Furthermore, Cohen discloses:

A procedure in accordance with claim 25, wherein:

the signature of the transmission of the license parameters from said licenser to said licensee occurs dependent on a unique Serial Number (SN) firmly assigned to said licensee (column 2 lines 50 – 55, column 4 lines 1 – 8).

Claim 27 is rejected as applied above in rejecting claim 25. Furthermore, Cohen discloses:

A procedure in accordance with claim 25 wherein:

said licenser is assigned a secret Firm Common Key (FCK), which is produced from a Common Key (CK) through encoding dependent on the Firm Code (FC) of said licensee (column 6 line 63 – column 7 line 8); and

the installation, changing, or deletion of the license parameters occurs dependent on the Firm Common Key (FCK) (column 6 line 63 – column 7 line 8).

Claim 28 is rejected as applied above in rejecting claim 25. Furthermore, Cohen discloses:

A procedure in accordance with claim 25 wherein:

the automatic decoding of the protected software or data occurs by means of an encoder and decoder arranged within the protective device (column 5 line 28 – column 6 line 37).

Claim 29 is rejected as applied above in rejecting claim 25. Furthermore, Cohen discloses:

A procedure in accordance with claim 25 wherein:

the protective device contains a limiter secure against manipulation that limits the time period and/or the number of decodings of the protected software of the protected software or data (column 7 lines 8 – 30).

Claim 30 is rejected as applied above in rejecting claim 25. Furthermore, Cohen discloses:

A procedure in accordance with claim 25 wherein:

a secret Private Box Key (BK) determined by a producer is stored in the protective device (column 2 lines 35 – 49, column 6 lines 1 – 37); and

the encoding of the transmission of the license parameters between said licenser and the licensee occurs dependent on this Private Box Key (BK) (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 32 is rejected as applied above in rejecting claim 31. Furthermore, Cohen discloses:

A protective device in accordance with claim 31, wherein:

the memory includes several memory areas for the storage of license parameters of different licensers (Figure 4 item 120, column 6 lines 11 – 20).

Claim 33 is rejected as applied above in rejecting claim 31. Furthermore, Cohen discloses:

the microprocessor, the memory, the encoder/decoder, and the installation for the production of the Private Serial Key (SK) are developed on a single integrated semiconductor circuit (ASIC) (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 34 is rejected as applied above in rejecting claim 31. Furthermore, Cohen discloses:

A protective device in accordance with claim 31 including:

a limiter secure from manipulation that limits the time period and/or the number of decodings of the protected software or data (column 7 lines 8 – 31).

Claim 18 is rejected as applied above in rejecting claim 17. Furthermore, Cohen discloses:

A procedure in accordance with claim 17 wherein:

the automatic decoding of the protected software or data occurs by means of an encoder and decoder arranged within the protective device (column 5 line 28 – column 6 line 37).

Claim 19 is rejected as applied above in rejecting claim 17. Furthermore, Cohen discloses:

A procedure in accordance with claim 17 wherein:

the protective device contains a limiter secure against manipulation that limits the time period and/or the number of decodings of the protected software or data (column 7 lines 8 – 31).

Claim 20 is rejected as applied above in rejecting claim 17. Furthermore, Cohen discloses:

A procedure in accordance with claim 17 wherein:

a secret Private Box Key (BK) determined by a producer is stored in the protective device (column 2 lines 35 – 49, column 6 lines 1 – 37); and

the encoding of the transmission of license parameters between said licenser and the licensee occurs dependent on this Private Box Key (BK) (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 22 is rejected as applied above in rejecting claim 21. Furthermore, Cohen discloses:

A protective device in accordance with claim 21, wherein:

the memory includes several memory areas for the storage of license parameters of different licensers (Figure 4 item 120, column 6 lines 11 – 20).

Claim 23 is rejected as applied above in rejecting claim 21. Furthermore, Cohen discloses:

A protective device in accordance with claim 21 wherein:

the microprocessor, the memory, the encoder/decoder, and the installation for the production of the Private Serial Key (SK) are developed on a single integrated semiconductor circuit (ASIC) (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 24 is rejected as applied above in rejecting claim 21. Furthermore, Cohen discloses:

A protective device in accordance with claim 21 including:

a limiter secure from manipulation that limits the time period and/or the number of decodings of the protected software or data (column 7 lines 8 – 31).

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaveh Abrishamkar whose telephone number is 703-305-8892. The examiner can normally be reached on Monday thru Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KA
10/29/04

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100